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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,376	12/08/2003	Michael Bothe	041165-9058-00	2839

23409 7590 12/02/2005

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EXAMINER

DATSKOVSKIY, MICHAEL V

ART UNIT	PAPER NUMBER
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2835

DATE MAILED: 12/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/730,376	Applicant(s) BOTHE ET AL.	
	Examiner Michael V. Datskovskiy	Art Unit 2835	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-8, 10, 11, 14, 16 and 17 is/are rejected.
- 7) ☒ Claim(s) 5, 9, 12, 13 and 15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>03/10/05, 03/24/05</u> . | 6) <input type="checkbox"/> Other: _____ |

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the guide means defining at least two locking positions (claim 2), and the guide means connection of the first housing component and the second housing component in an electrically conductive manner (claim 10) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

Art Unit: 2835

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 2 and 10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The guide means defining at least two locking positions (claim 2), and the guide means connection of the first housing component and the second housing component in an electrically conductive manner (claim 10) neither described in the description nor shown in the drawings in a way to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In the current application applicant stated/claimed an existence but did not provide any embodiment of particular mechanism(s), which would synchronously lock/unlock the main plug in certain position and provide/disconnect electrical connection between first and second housing components, as it is shown for example by Hahn (US Patent 5,628,641).

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 15, 16 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claims 15, 16 and 17 each recites the limitations: "the insertion direction; the plug-in direction, and the second charging position (in claim 16)" in lines 2-3. There is insufficient antecedent basis for this limitation in the claim.

7. Regarding claim 11, the phrase "such that" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

8. Regarding to claim 17: The transport position neither makes possible "insertion" nor "plug-in". Therefore, it does not make technical sense to claim these operations in connection with the voltage transformer folded in the transport position.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-4, 6-8, 10, 14, 16 -17, as best understood by examiner, are rejected under 35 U.S.C. 102(b) as being anticipated by Hahn (US Patent 5,628,641).

In regard to claims 1, 3: Hahn teaches a voltage transformer, Figs. 1-8, comprising: a housing including a main plug 10 connectable to a main voltage source, a terminal plug 64 connectable to a terminal, and a voltage transformer circuit 7, said housing comprising a first housing component 12 and a second housing component 1 movably connected to the first housing component 12 by a rotary guide means 14, 28 and implemented as a reception means for receiving therein the terminal 68, said voltage

Art Unit: 2835

transformer adapted to move from a transport position to a first charging position, wherein, at the transport position, the housing components 1 and 12 have been moved relative to one another such that the space occupied at the transport position is smaller than that occupied at the first charging position.

In regard to claims 2, 4, 6, 8 and 16: Hahn teaches said voltage transformer, wherein the rotary guide means defining two locking positions: transport, wherein the second housing component 1 implemented as a protective casing enclosing the main plug 10, wherein the first housing component 12 is folded onto the second housing component 1; and the charging position, wherein the main plug 10 extends away from the terminal plug at an angle of about 90 ° (transverse to one another).

In regard to claims 10, 11: Hahn teaches said voltage transformer, wherein said guide means movably connect the first housing component 12 and the second housing component 1 in an electrically conductive manner (see Figs. 8a-8c); and said main plug 10 is arranged such that it can be exchanged so as to be compatible with different, country-specific mains sockets (col. 3, lines 3-9).

In regard to claims 7 and 17: Hahn teaches said voltage transformer, wherein either in transport or in charging positions the insertion and plug-in directions are parallel (in alignment) to/with each other.

Regarding to claim 14: It is inherent that terminal plugs 64 can be replaced.

Allowable Subject Matter

11. Claims 5, 9, 12-13 would be allowable if rewritten to include all of the limitations of the base claim and any intervening claims.

Art Unit: 2835

12. Claim 15 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

13. The following is a statement of reasons for the indication of allowable subject matter: The voltage transformer of claim 1 having a second charging position (claim 5), wherein the insertion direction and the plug-in direction are parallel to one another (claim 15); The voltage transformer of claim 1, wherein the first housing component is implemented such that it encloses the terminal plug in the transport position (claim 9); The voltage transformer of claim 1, wherein the voltage transformer circuit is integrated in the first housing component (claim 12), and has a fork-shaped structural design having a rotary guide means at the fork ends (claim 13).

14. The prior art made of record in the PTO Form 892 and not relied upon is considered pertinent to applicant's disclosure.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael V. Datskovskiy whose telephone number is (571) 272-2040. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynn Feild can be reached on (571) 272-2092. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2835

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Michael V Datskovskiy
Primary Examiner
Art Unit 2835

11/29/2005